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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|-----------------|-------------|----------------------|---------------------|------------------|
| 09/744,484 | 05/21/2001 | Horst Grafe | HM-390PCT | 5641 |

7590

08/08/2005

Friedrich Kueffner
317 Madison Avenue
New York, NY 10173

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| EXAMINER |
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PRONE, JASON D

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| ART UNIT | PAPER NUMBER |
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3724

DATE MAILED: 08/08/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/744,484

Applicant(s)

GRAFE ET AL.

Examiner

Jason Prone

Art Unit

3724

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 04 April 2005.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-8 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-8 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 04 April 2005 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

DETAILED ACTION

Allowable Subject Matter

1. The indicated allowability of claims 1-8 is withdrawn in view of the newly discovered rejections under 35 U.S.C. 112.

Specification

2. The disclosure is objected to because of the following informalities: In the newly added paragraph with the heading "Please replace the paragraph before the paragraph beginning at page 14, line 16 with the following (this paragraph was inadvertently left out of the clean copy of the substitute specification, but was present in the marked-up version):" on page 4 of the amendment to the specification, on line 9, applicant should replace the phrase "gliding plates." With "gliding plates 26, 26'". Also, on lines 11-12 of the same paragraph, the phrase "gliding plate across" should be replaced with "gliding plate 24, 24' and 26, 26' across".

Appropriate correction is required.

Claim Rejections - 35 USC § 112

3. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

4. Claims 1-8 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the enablement requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention. It

is unclear how the clamp element (7) performs its intended function and allows the drive carriage (9) and the movable part of the rolling table (2') to perform their intended functions. First, using Figure 3, it is clear that the shape of the clamp element (7) is a large rectangle with the lower corners missing and that the gliding plates (24 and 24') are located towards a vertical center line of the clamp element (7), however, in Figure 2, it appears that the gliding plates (24) are on the side of the clamp element (7) due to the fact that you can see the gliding plates on the side view. It is unclear how the gliding plate structure and the clamping element interact or how they are connected to one another. It is clear from the specification and Figure 2 that the clamp element (7) is lifted up by coupling element (21) and actuating member (11) and moved over by actuating members (25, 25') then set down on pressure plate (23). In light of this movement, it is not clear how gliding plates (26, 26') would be placed onto their corresponding pressure plates (37, 37'). If the clamp element (7) is lifted up as shown in Figure 2, the gliding plates (26, 26') would be above pressure plates (37, 37'). It is not clear how the both set of gliding plates are set on their corresponding pressure plates with the lifting movement disclosed in the specification. If the clamp element (7) has a solid rectangle-like shape as depicted in Figure 3, it is unclear how the clamp element (7) can be in the position as depicted by the ghost lines in Figure 1 and 2 and not interfere with holding elements (6, 6'). The center of the clamp element (7) would have to occupy the exact space as the holding elements (6, 6'). Also, using Figure 2 and 3, gliding plates (26 and 26') do not appear to be connected to the clamp element (7). It is unclear how the clamp element (7) is connected with gliding plates (26, 26').

Art Unit: 3724

Also, it is unclear how the clamp element (7) generates both a positive and a non-positive coupling. A positive coupling would be two things coupled together while a non-positive coupling would be the opposite of two things coupled together and therefore, would not be coupled at all. The specification only discloses one movement for the clamp element (7). The coupling elements 21 lift the clamp element (7) into and out of the gliding path (38). There is no mention of the clamp element (7) being moved with the frame (20) or movable part (2'). Also, there is no mention of where the gliding path is located. As best understood, from Figure 1, the clamp element (7) along with the actuator (25) and gliding path (38) appear to be offset and not connected to either of the frame (20) or movable part (2') making the clamp element (7) independent from the horizontal moving parts (9 and 2'). The vertical centerline of the clamp element (7), in Figure 3 appears to be aligned with the vertical centerline of the frame (20). Restating the fact that the specification and the drawings of the instant application do not disclose that the clamp element (7) is movable with the horizontal moving parts (9 and 2'), it is not clear how the movable part (2') can move to the x-x position when the clamp element (7) is in the way thereby blocking any movement. In order for the movable part (2') to re-locate to the intended position of x-x, the movable part would have to go through the clamp element (7). Due to lack of specific details of the clamp element (7) it is unclear how the clamp element (7) actually clamps and how the horizontal moving parts (9 and 2') perform a function around the stationary clamp element (7). Any incorporation of the location of the clamp element (7) and any further details of the clamp element (7) in a future response could be considered new matter.

5. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

6. Claims 3-6 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

7. In regards to claim 3, the phrase "the drive carriage (9) at the rolling table side receives at least clamping element" is unclear. The specification and the drawings do not disclose that the clamping element (7) interacts with any other structure besides gliding path (38). It is unclear what structure allows the clamping element (7) to interact with the carriage (9).

8. In regards to claims 4 and 5, it is unclear how the clamping element (7) couples with the holding element (6, 6'). See lines 20-25 of paragraph 3 above.

9. In regards to claim 6, the phrase "generating a positive and non-positive coupling" is unclear. See lines 28-31 of paragraph 3 above.

10. It is to be noted that claims 1-8 have not been rejected over prior art. It may or may not be readable over the prior art but cannot be determined at this time in view of the issues under 35 USC § 112.

Conclusion

11. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jason Prone whose telephone number is 571-272-4513. The examiner can normally be reached on 7:30-5:00, Mon - (every other) Fri.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Allan N. Shoap can be reached on 571-272-4514. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



JP
August 01, 2005



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